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09/456,371	12/08/1999	HEINRICH BOLLMANN	12010	6395
28484	7590	06/05/2008	EXAMINER	
BASF AKTIENGESELLSCHAFT CARL-BOSCH STRASSE 38, 67056 LUDWIGSHAFEN LUDWIGSHAFEN, 69056 GERMANY			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1794	
		NOTIFICATION DATE	DELIVERY MODE	
		06/05/2008	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/456,371	<b>Applicant(s)</b> BOLLMANN ET AL.
	<b>Examiner</b> Victor S. Chang	<b>Art Unit</b> 1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 28 April 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 19,20,22,23 and 30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 19,20,22,23 and 30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Introduction***

1. Applicants' remarks filed on 4/28/2008 have been entered. Claims 19, 20, 22, 23 and 30 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the arguments, the grounds of rejections are updated as set forth below.

***Claim Rejections - 35 USC § 112***

4. The amended specification and drawings filed 11/17/2003, and the structure of claim 23 added 9/7/2001, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. They contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, in an interview on 11/14/2007 applicants argue that the support for the structure of claim 23 is supported by the amended specification and drawings in an amendment filed 11/17/2003, which was entered in an Office action mailed 1/7/2004. However, upon a careful review, since the amended specification and drawings filed 11/17/2003 are unsupported in the original specification, these amendments and claim 23 added 9/7/2001 are deemed to be new matter. Again, applicants must cancel new matter, or provide a clear support in the original specification.

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5. Claims 19, 20, 22, 23 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, in accordance to applicants' argument filed 1/2/2008, at Remarks page 9, that the terms "rigid" and "flexible", added in amendment filed 2/23/2006, are structural features of the damping elements, not inherent material properties of composition of the components. However, throughout the original specification, nowhere can a support be found for these structural features, therefore they are deemed to be new matter. Applicants are again requested to provide a clear support in the next reply.

6. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, the structural limitation "elastomer layer is bonded to an outer surface of said molding" in claim 23 is vague and indefinite, because the original specification lacks any disclosure of a workable embodiment having a structural relationship which can be reasonably interpreted as a support for the claimed limitation. More particularly, in the absence of any structural description for a workable vehicle damping element in the original specification, it is unclear what constitutes the scope and/or structural relationship as the "outer surface".

***Response to Arguments***

7. Applicants argue at pages 6-8 that the Examiner is applying an improper standard and the Examiner has failed to satisfy the requisite burden set forth in MPEP 2163.06. Applicants further contend that the examiner has not provided an explanation regarding the enablement of the claimed subject matter. However, since the core issues are new matter, rejecting new matter under 112, first paragraph, is proper. Further, since nowhere has the examiner made an enablement rejection, applicants' argument is misplaced.

Applicants argue at pages 9-10 that

"One of ordinary skill in the art of motor vehicle composite damping elements, as shown by "Fahrwerktechnik: Radaufhangungen", 2<sup>nd</sup> Edition, ed. Prof. Dipl. -Lug. Jomsen Reimpell, Vogel Buchverlag Wurzburg, which is discussed on page 1, lines 23-26, of the specification as originally filed, would understand that the inventors were in possession of complex structures forming the damping elements. One of ordinary skill, in the art of bonding the flexible microcellular polyurethane elastomer layer to rigid thermoplastic polyurethane molding would understand that the inventors were in possession of chemically bonding to any surface of the rigid thermoplastic polyurethane molding."

However, the examiner has explained in prior Office action (mailed 1/28/2007, page 5) that all the vehicle composite damping elements in Fahrwerktechnik: Radaufhangungen are metal/rubber composites. While the reference provides various complex structures of metal/rubber composite damping elements, there is no evidence whatsoever to one of ordinary skill in the art to believe that the metal/rubber components of any of the structures of in the reference can be simply replaced with significantly different and mechanically much weaker materials of TPU/PU foam of the instant invention, without any structural modifications, and the resultant articles are workable replacements meeting equivalent performance requirements, such as vehicle damping properties and durability of the elements, as the metal/rubber composites. The examiner maintains that in the absence any evidence that any workable replacements meeting the

performance requirements are obtained with the same structures shown in the reference, the reference merely provides exemplary structures of metal/rubber composites, and applicants have failed to disclose any workable structures of TPU/PU composites. More particularly, nowhere has the specification stated that workable replacements are obtained by simply replacing the metal/rubber components with TPU/PU foam components, while maintaining the same structure. Any recitation of the structures of metal/rubber composites in the reference is deemed to be new matter, because the reference does not contain any TPU/PU foam composites

Pointing to various sections of the specification, applicants argue at pages 10-14 that

"Applicant has demonstrated that the subject invention was a replacement for well-known metal-rubber damping elements as reflected in "Fahrwerktechnik: Radaufhangungen", Exhibit A. Thus, one of ordinary skill in the art of damping elements would find adequate support for the structural element "elastomer layer is bonded to an outer surface of said molding" of claim 23. All of these well-known metal-rubber damping elements are complex shapes that have more than one surface. Necessarily, these shapes have inner and outer surfaces. Therefore, one of ordinary skill in the relevant art would reasonably understand that the inventors possessed bonding the flexible microcellular polyurethane elastomer layer to the rigid thermoplastic polyurethane molding."

However, applicants fail to point out where in the reference Exhibit A is found. Applicants' speculation that one of ordinary skill in the art would find support for the structural element in claim 23 lacks evidentiary support in the original specification. The examiner maintains that claim 23 contains new matter.

Applicants argue at page 14 that

"Applicant is merely referring to Exhibit A to illustrate numerous prior art damping elements having different orientations and configurations of the rigid metal and flexible rubber. Applicant is not contending that the subject invention withstands the same forces as those disclosed in Exhibit A, simply that prior art damping elements are well known. Page 13 illustrates one damping element, shown as a shock-absorber bearing in Figure 1.10, having rubber supported both on an inner face of one metal component and an outer face of another metal component."

However, since Exhibit A is absent from original specification, its structural features are new matter. As to Fig. 1.10 of the reference, applicants are again reminded that Fig. 1.10 is a metal/rubber composite, no evidence whatsoever has been shown the same structure is workable for TPU/PU foam composite for the same required performance properties. With respect to applicants' statement that "Applicant is not contending that the subject invention withstands the same forces as those disclosed in Exhibit A," the examiner notes that applicants appear to have admitted that the "TPU/PU foam replacement composites" would fail to meet the performance properties of metal/rubber composites, i.e., inadequate and not enabled. Further, applicants are reminded that all the structures of metal/rubber composites in the reference are designed for vehicle damping elements, there is no disclosure in the reference, nor in the specification of instant application, that these structures can be used for applications which can only withstand less forces.

Applicants argue at pages 14-15 that

"Referring now to Figure 3.85 on page 205, a transverse link bearing is shown having two rubber parts 4 around a metal inner tube 1. The rubber 4 is vulcanized to and surrounds an outer face & the inner tube 1 and an inner face of the ring 2. With reference to Figure 5.45 on page 369, an eye-type joint for a shock-absorber is shown having rubber surrounding an outer face of a metal tube and adhered to an inner face of a metal plate. Figure 5.46 on page 370 illustrates a pin-type joint that includes rubber on an inner face of one metal plate and an outer face of another metal plate."

However, applicants are again reminded that abovementioned figures relate to metal/rubber composites. For the same reasons set forth above, applicants' arguments are misplaced, because they are not TPU/PU foam composites.

Applicants argue at pages 16-17 that

"In view of MPEP 2164.02, it is not necessary to provide workable embodiments are improperly relied upon by the Examiner. Applicant disagree that this example, cited by the Examiner, limits the invention. This example was utilized to determine the strength of the bond of the microcellular polyurethane to the TPU. In fact, this example adequately describes the configuration of one of the prior damping elements described above on page 369 of Exhibit having rubber contacting the inside of one metal part and contacting the outside of another metal part. Thus, the passage identified by the Examiner does not exclude the limitation of elastomer layer is bonded to an outer surface of said molding" and in fact supports Applicant's arguments that such a limitation was described in sufficient detail that one skilled in the art could reasonably conclude that the inventor had possession of the claimed invention."

However, the examiner merely points to structural support for claim 22 can be found at specification page 10, and claim 23 lacks a support in the original specification. Nowhere has the examiner made a statement that page 10 limits the scope of the invention. Regarding page 369 of Exhibit, applicants again improperly misplaced support for claim 23 on the structure of a metal/rubber composite, as set forth above.

Applicants argue at pages 18-19 that

"The *rigid* thermoplastic polyurethane molding has replaced the metal component and the *flexible* microcellular layer has replaced the rubber component.

...

Webster dictionary defines rigid as "very firm rather than pliant in composition or structure : lacking or devoid of flexibility : inflexible in nature" and defines flexible as "characterized by ready capability for modification or change, by plasticity, pliancy, variability, and often by consequent adaptability to new situations".

The terms "rigid" and "flexible" are inherent within the description of the subject invention being a replacement for well-known rubber-metal damping elements. As further set forth in MPEP 2163.07(a), by disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter."

Clearly, according to the definitions in Webster dictionary provided by applicants, the terms "rigid" and "flexible" relate to properties of *composition or structure*. Applicants are reminded that in prior Office action mailed 10/3/2007 page 5, these terms have been interpreted as

inherently properties of composition, in accordance to the usage of these terms in the specification. However, applicants have contended in arguments filed 1/2/2008 that the intended scopes of these terms in amended claim 19 relate to structural features of the damping elements. Accordingly, the relied upon prior art of record has been withdrawn in prior Office action mailed 1/28/2008, because it lacks “rigid” and “flexible” structural features. Nevertheless, since the original specification lacks support for “rigid” and “flexible” structural features, these terms in claim 19 are rejected as new matter, as set forth above in section 5.

Applicants argue at page 19 that

“Applicant submits that the specification, as referenced above, explicitly states the advantage and function of the claimed invention comprising the rigid TPU molding and flexible elastomer.”

However, applicants’ argument is clearly incommensurate with arguments filed 1/2/2008. Since applicants has already set forth the scope of the terms as “rigid” and “flexible” structural features, the rejection over 112, 1<sup>st</sup> paragraph, as set forth above, is maintained. Applicants’ argument to the contrary is not accepted.

### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794